



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,823	06/25/2003	Olivier De Lacharriere	016800-515	1993
<div>7590 01/25/2008 BURNS, DOANE, SWECKER &amp; MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404</div>			<div>EXAMINER DUTT, ADITI</div>	
			<div>ART UNIT 1649</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 01/25/2008</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,823	<b>Applicant(s)</b> LACHARRIERE ET AL.	
	<b>Examiner</b> Aditi Dutt	<b>Art Unit</b> 1649	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25,27-54 and 56-67 is/are pending in the application.
- 4a) Of the above claim(s) 39,40,45,46 and 64-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,27-38,41-44,47-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. The amendments filed on 28 September 2007 have been entered into the record and have been fully considered. Claim 2 is amended.
2. Claims 1-25, 27-38, 41-44, 47-54, 56-63, directed to a non-therapeutic method of evaluating level of skin neurosensitivity and identifying persons having sensitive skin are under examination in the instant application.
3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicants response and withdrawn.
4. Applicant's arguments filed on 28 September 2007, have been fully considered. New grounds of objection and rejection are as follow.

### ***Response to Amendment***

#### **Withdrawn objections and/or rejections**

5. Upon consideration of the Applicant's amendment, all claim objections and rejections, not reiterated herein have been withdrawn, as overcome by cancellation and/or amendment of claims (28 September 2007).
6. Rejection of claims 3, 5-9 and 16 under nonstatutory obviousness-type double patenting are withdrawn because of the filing of the terminal disclaimer.

Claim rejections/objections maintained/new grounds of rejection

35 U.S.C. 112-first paragraph- Written Description.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The rejections of claims 1-25, 27-38, 41-44, 47-54, 56-63 are applied to the amended claims, for reasons of record in the Office Action dated 31 May 2007.
8. Contrary to Examiner's rejection, Applicant argues that the specification sufficiently describes the terms "peripheral nervous system stimulant", "physiologically acceptable vehicle" and "unattractive sensation" recited in the instant claims. Applicant cites paragraphs in the specification teaching such terms, which are also recited in the instant claims. The Applicant asserts that the terms are known and understood by the skilled artisan. Thus the specification provides sufficient written description of the invention and, therefore, the rejection should be withdrawn.
9. Applicant's arguments have been fully considered but have not been found to be persuasive. Although, the species of peripheral nervous system stimulants, cosmetics and vehicles are listed, the specification does not teach a definitive structure function relationship of the above mentioned claimed genus of stimulants that can be correlated with the genus of unattractive sensations produced by them. Mere knowledge of the structure does not provide adequate

distinguishing characteristics of the entire genus of peripheral nervous stimulants necessary for detecting neurosensitivity. Additionally, as mentioned in the specification, the function of unattractive skin sensation can be produced by a host of other unrelated factors such as the environment, emotional and physiological changes, dietary and other topical applications, giving rise to a variety of subjective and objective responses to different stimuli in different subjects. As stated in the previous Office Action,

With the exception of capsaicin as the peripheral nervous system stimulant, the skilled artisan cannot envision the peripheral nervous stimulants, cosmetics, vehicles and unattractive sensations of the encompassed methods and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of detecting skin neurosensitivity.

10. Therefore, methods of using a specific cosmetic or capsaicin in a specific vehicle, and a specific unattractive sensation to detect skin neurosensitivity, but not the full breadth of the claims meets the written description provision of 35 U.S.C. §112, first paragraph.

103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The rejection of claims 1-17, 20-25, 27, 28-38, 41-44, 48-54, as unpatentable over Robinson and Perkins (Contact Dermatitis 45: 205-213, 2001)

are applied to the amended claims for reasons of record in the Office Action dated 31 May 2007.

12. Applicant argues that the reference does not show consistency between the intensity of the recalled/imagined sensation and the measured reactivity after a product application. Applicant further argues that the data of Robinson et al. having "considerable variability between individual subjects" does not provide a reliable evaluation of skin neurosensitivity. Furthermore, Applicant believes that Robinson et al does not suggest low concentrations of capsaicin, as recited in the instant claims, which is important for cosmetic diagnosis to select individuals having more sensitive skin, thus avoiding false positive results. Hence, Applicant believes that the reference would teach away from using capsaicin to classify a population with sensitive skin.

13. Applicant's arguments have been fully considered but have not been found to be persuasive. Robinson et al. uses the labeled magnitude (LM) scale for quantifying sensory irritation responses, which correlate with the actual responses observed after different doses of capsaicin challenge. Although Robinson et al. do not teach the instant doses of the stimulant, optimization within prior art conditions or through routine experimentation is obvious to one skilled in the art. As stated in the previous Office Action,

It would have been, therefore, obvious to the person of ordinary skill in the art at the time the claimed invention was made to determine the optimal ranges of capsaicin and alcohol content in the solution of the skin neurosensitivity testing method as taught by Robinson. The person of ordinary skill in the art would have

been motivated to perform such tests on sensitive skin to assess the response to various products and chemicals (Robinson).

14. Furthermore, Robinson et al. teach a fairly objective measurement, whereby even though "there is little response consistency within individuals", a "collective response to these recall/imagined skin stimuli" demonstrate a general consistency in the "mean population level response" (page 212, col 1, para 2). Additionally, Applicant's arguments about the recalled/imagined sensation inconsistency is moot, because the instant claims also do not recite any objective measurement for the chemosensory reactivity of the applying product, that would counter the "inconsistency" allegation.
15. Thus, claims 1-17, 20-25, 27, 28-38, 41-44, 48-54 as a whole is *prima facie* obvious over the teachings of Robinson et al, and stay rejected.
16. The rejection of claims 56-63 under 35 U.S.C. 103(a) as being unpatentable over Robinson and Perkins (Contact Dermatitis 45: 205-213, 2001), as applied to claims 1-17, 20-25, 27-38, 41-44 and 48-54 above and further in view of Hahn and Thueson (U.S. Patent No. 6,139,850, issued on 31 October 2000), are applied to the amended claims for reasons of record in the Office Action dated 31 May 2007.
17. Applicant questions the rejection of claims 56-63 "over Robinson et al, at further in view of Hahn et al.", and alleges that the citation of Hahn et al. is meaningless, because "claims 1-17, 20-38, 41-44 and 48-55 over Robinson et al.

did not include claims 56-63" in the last Office Action dated 31 May 2007 (page 6-7, para 12-14). Applicant requests clarification on the rejection of the specific claims.

18. Applicant's arguments have been fully considered and have been found to be persuasive in part. Examiner acknowledges a typographical error on page 6, para 12 of the Office Action dated 31 May 2007, and apologizes for the confusion caused thereby. It is corrected as stated above (see para 16 of the instant Action), based on the Office Action dated 14 September 2006 (page 12, para 30).
19. As stated in the previous Office Action of 14 September 2006, Robinson et al. do not teach the use of cosmetics. Hahn et al. teach skin and facial irritation by using a benzoyl peroxide wash product (Oxy 10). A person of ordinary skill would be motivated to modify the method of Robinson et al in conjunction with cosmetics as a function of skin neurosensitivity as taught by Hahn et al. Barring the confusion caused by the typographical error in stating the claim numbers, Applicant did not present additional arguments traversing the rejection over Hahn et al., and since claims 1-17, 20-25, 27-38, 41-44 and 48-54 are rejected over Robinson et al for reasons explained above, claims 56-63 are further rejected in view of Hahn et al.



***Conclusion***

20. No claims are allowed.
21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aditi Dutt whose telephone number is (571) 272-9037. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 5:00 p.m.
24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached on ~~(571) 272-0911~~. The

Application/Control Number:  
10/602,823  
Art Unit: 1649

Page 9

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD  
15 January 2008



GARY B. NICKOL, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600